

## **REMARKS**

### **I. The Claims**

Claims 1, 3, 5, 7, 9-11, 13, and 16 have been amended. Claims 2 and 17-30 have been canceled. Applicants reserve the right to present the subject matter of claims 17-30 in a divisional application.

Applicants acknowledge with appreciation the Examiner's indication that claims 6, 14, and 15 contain allowable subject matter.

### **II. The Restriction Requirement**

In the Office Action, the Examiner asserts that the application contains claims directed to the following patentably distinct species: (a) a compound derived from a polyol and a lactone wherein the polyol may be selected from (i) an acrylic polyol and (ii) a polysiloxane polyol, and (b) a film-forming resin wherein there are innumerable types of known film-forming polymers. See Office Action at 2.

Applicants affirm their provisional election to select the species wherein the polyol is acrylic and the film-forming resin is a polyester. Accordingly, Applicants have herein amended claim 1 and canceled claims 17-30. Applicants reserve the right to present the subject matter of the canceled claims in a divisional application.

### **III. The Examiner's Claim Analysis**

In the Office Action, the Examiner asserts that the mention in a reference of a compound derived from a polyol and a lactone, wherein the polyol is an acrylic polyol, would constitute an anticipation of both components (a) and (b) of the pending claims as Applicants have not stipulated that (a) and (b) are different. See Office Action at 3. Applicants respectfully disagree with this interpretation of the claims for the following reasons.

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. See MPEP 2111 (citing *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) (emphasis added)); see also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) ("PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as

they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification") (emphasis added).

In this case, Applicants respectfully assert that the Examiner's interpretation of the claims is inconsistent with the specification. In particular, Applicants refer the Examiner to the last three sentences of paragraph [0025], wherein Applicants state:

It will be further appreciated that the polymer additives or comb polymers used in the powder coatings of the present invention are used in additive quantities. That is, they are in quantities sufficient to form a film themselves; an additional quantity of a separate film-forming resin should be used in sufficient quantity to form a film. Thus, the "film-forming resin" as used herein does not refer to the comb polymer.

(emphasis added)

As a result, Applicants made clear in the specification that, contrary to the Examiner's claim analysis, components (a) and (b) of claim 1 are not one and the same. Instead, the film-forming resin is a separate component of the claimed powder coating composition and does not refer to the comb polymer.

Applicants, therefore, respectfully request that the Examiner reconsider his analysis of claim 1. The mention in a reference of a compound derived from a polyol and a lactone, wherein the polyol is an acrylic polyol, cannot constitute an anticipation of both components (a) and (b) of the pending claims.

#### **IV. The Claim Rejections**

Turning to the claim rejections, the Examiner rejects claims 1-5, 7-13, 16, and 28 under 35 USC 102(b) as being anticipated by United States Patent No. 4,988,763 ("Kessler") and claims 1, 5, 7, 9, 11-13 and 28 under 35 USC 102(b) as being anticipated by JP 54-125232 ("Takezawa"). Applicants respectfully traverse these rejections for the reasons that follow.

##### **1. Kessler et al.**

Kessler is directed to a catalyzed bulk process for producing cyclic ester-modified polymers and to the polymers produced. See col. 1, lines 7-9. According to the disclosed invention, unique film-forming components are allegedly formed through the reaction of hydroxyl group containing vinyl polymers, such as acrylic polyols, and cyclic esters, with the reaction

being carried out at 100% solids utilizing a selected catalyst. See col. 2, lines 28-32. The products of the invention purportedly have application in the fabrication of liquid and powder protective coatings. See col. 6, lines 61-64.

Kessler neither discloses nor suggests any curable powder coating composition of the present invention. In particular, Kessler neither discloses nor suggests any curable powder coating composition comprising the combination of: (a) a compound that comprises the reaction product of a polyol having at least one hydroxyl group and a lactone, wherein the polyol comprises an acrylic polyol; (b) a separate film-forming resin that is not the compound (a); and (c) a crosslinker.

As indicated in the present application, the inclusion of the additive (a) in combination with a separate film-forming resin in a curable powder coating composition can result in at least one improvement to the performance characteristics of such compositions, such as improved flow and/or improved leveling, decreased gassing, increased flexibility, and/or improved appearance. See [0025]. There is no disclosure or suggestion in Kessler that such a compound could be used in a curable powder coating composition in combination with a separate film-forming resin to achieve such results.

As a result, Applicants respectfully request withdrawal of the pending rejections in view of Kessler.

2. Takezawa et al.

Takezawa is directed to powder coatings with high shelf stability that is prepared by combining a vinyl copolymer containing lactone-modified hydroxyl groups with a curing agent bearing groups capable of reacting with the hydroxyl groups, thus giving coating films with high luster, weathering resistance, and excellent physical and chemical properties. See Abstract.

Like Kessler, however, Takezawa neither discloses nor suggests any curable powder coating composition of the present invention. In particular, Takezawa neither discloses nor suggests any curable powder coating composition comprising the combination of: (a) a compound that comprises the reaction product of a polyol having at least one hydroxyl group and a lactone, wherein the polyol comprises an acrylic polyol; (b) a separate film-forming resin that is not the compound (a); and (c) a crosslinker.

As indicated in the present application, the inclusion of the additive (a) in combination with a separate film-forming resin in a curable powder coating composition can result in at least

Application No. 10/804,685  
Amendment Dated August 1, 2006  
In Reply to USPTO Office Action Dated May 3, 2006  
Attorney Docket No.: 1922A1

one improvement to the performance characteristics of such compositions, such as improved flow and/or improved leveling, decreased gassing, increased flexibility, and/or improved appearance. See [0025]. There is no disclosure or suggestion in Takezawa that such a compound could be used in a curable powder coating composition in combination with a separate film-forming resin to achieve such results.

As a result, Applicants respectfully request withdrawal of the pending rejections in view of Takezawa.

Application No. 10/804,685  
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**CONCLUSION**

Applicants respectfully request entry of the foregoing amendment and allowance of the application at an early date.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Donald R. Palladino", is written over a horizontal line.

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